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TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER LOEWE, ROBERT S	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUYUKI MIYAZAWA
and TAKASHI OKA

Appeal 2009-008775
Application 10/534,399
Technology Center 1700

Before MICHAEL P. COLAIANNI, ADRIENE LEPIANE HANLON, and
MARK NAGUMO, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

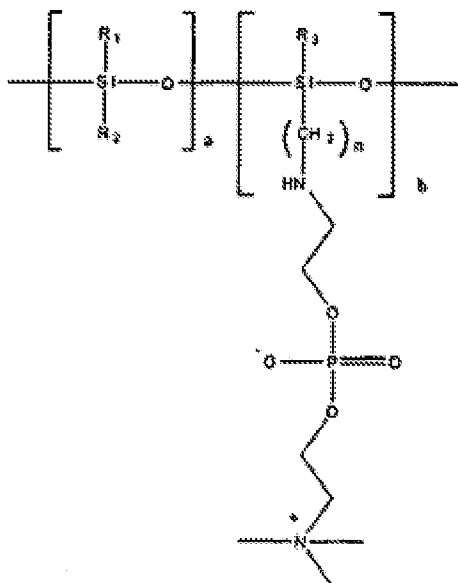
A. STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from an Examiner's decision finally rejecting claims 2, 4, and 5 under 35 U.S.C. § 112, first paragraph, based on the written description requirement. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The subject matter on appeal is directed to a polysiloxane having repeating units a and b or repeating units a, b, and c. Claim 2, reproduced below in relevant part, is illustrative.

2. A polysiloxane having repeating units a and b represented by the following formula (5):



(5)

wherein R_1 , R_2 , and R_3 , independently of each other, denote an alkyl group or perfluoroalkyl group having 1-22 carbon atoms, an alkoxysilyl group having 1-6 carbon atoms via an alkylene group having 1-6 carbon atoms, a phenyl group, or hydroxyl group, n denotes an integer 1-22; and a and b denote constituent units of the polysiloxane

Appeal Brief dated September 30, 2008 (“App. Br.”), Claims Appendix (emphasis added).

Similarly, claim 5 recites “[a] polysiloxane having repeating units a, b and c” represented by formula (7) wherein “a, b and c denote constituent units of the polysiloxane.” App. Br., Claims Appendix.

B. DISCUSSION

The only issue on appeal is whether the Examiner reversibly erred in finding that the original disclosure does not provide written description support for the limitations that “a and b denote constituent units of the polysiloxane” (claims 2 and 4) and “a, b and c denote constituent units of the polysiloxane” (claim 5).

There is no dispute that the original disclosure provides literal support for the claim language at issue. *See* Examiner’s Answer dated December 8, 2008 (“Ans.”), at 4; App. Br. 18-19; Reply Brief dated February 5, 2009, at 9; Spec. 13:8-10. Nonetheless, the Examiner contends that the claims on appeal do not comply with the written description requirement of 35 U.S.C. § 112, first paragraph, because the Appellants do not provide numerical values for a, b, and c in the Specification or the claims. Ans. 3-7.

The test for determining compliance with the written description requirement of § 112, first paragraph, is whether the disclosure of an application, as originally filed, reasonably conveys to one of ordinary skill in the art that the inventor had possession at that time of the later *claimed* subject matter. *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

Admittedly, the claims on appeal do not recite numerical values for a, b, and c. Thus, for purposes of the written description requirement, it is immaterial whether numerical values for a, b, and c are provided in the

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original disclosure. For this reason, the Examiner's § 112, first paragraph, rejection based on the written description requirement will be reversed.

C. DECISION

The decision of the Examiner is reversed.

REVERSED

sld

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